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Expedited Examination Under
37 CFR 1.116
Group 1635

#104
B. Webb
6/29/00

PATENT
Docket No. 760-248P

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Shoji TSUJI et al.

APPLN. NO.: 09/101,132 GROUP: 1635

FILED: June 30, 1998 EXAMINER: J. Epps

FOR: cDNA FRAGMENT OF GENE CAUSATIVE OF SPINOCEREBELLAR
ATAXIA TYPE 2 (as amended)

AMENDMENT UNDER 37 CFR § 1.116

Assistant Commissioner of Patents
Washington, DC 20231

June 21, 2000

Sir:

In response to the Office Action dated January 21, 2000, the following amendments and remarks are respectfully submitted in connection with the above-identified application.

OKAY to Enter
JE 4-19-01

IN THE CLAIMS:

Please cancel claims 12, 13 and 15.

Please amend the claims as follows:

14. (amended) A vector comprising an isolated nucleic acid according to any one of claims [8-13] 8-11 operatively linked to a promoter effective for expressing said nucleic acid in a human cell.

REMARKS

The Office Action of January 21, 2000, presents the examination of claims 8-18. Claims 12, 13 and 15 are canceled herein, without prejudice to or disclaimer of the subject matter thereof. The dependency of claim 14 is amended to remove dependence from canceled claims. Claims 8, 9 and 16-18 are indicated as allowed.

Rejection for Lack of Enablement

Claims 12-15 stand rejected under 35 U.S.C. § 112, first paragraph, for alleged lack of enablement by the specification. Claims 12, 13 and 15 are canceled, rendering the rejection moot as to those claims. Claim 14 appears to be rejected only to the extent it depends from rejected base claims. The dependency of claim 14 is amended appropriately, thus obviating this rejection as to claim 14.

Rejection Over Prior Art

Claims 10 and 11 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Rabinovitch. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

Rabinovitch discloses chromosome-specific libraries, that is, a plurality of DNA molecules produced by the methods described in the patent. That method includes steps of restriction digestion and random ligation of adaptors, followed by PCR. Such a method would generate a

large number of different DNA fragments having distinct nucleotide sequences. The Examiner should note that "libraries" as collections are distinguished from "members" that are individual DNA fragments (col. 10, lines 39-61). Rabinovitch does not disclose any member of a library that would correspond to an "isolated nucleic acid" described by the present claims 10 and 11. Accordingly, Rabinovitch does not anticipate the present invention and the instant rejection should be withdrawn.

Applicants submit that the pending claims should now be found in condition for allowance. If there are any minor matters precluding allowance of the application which may be resolved by a telephone discussion, the Examiner is respectfully requested to contact Mark J. Nuell, Ph.D. (Reg. No. 36,623) at (703) 205-8000.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), the Applicants hereby petition for an extension of two (2) months to June 21, 2000 in which to file a reply to the Office Action. The required fee of \$380.00 is enclosed herewith.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees

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required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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